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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,472	12/12/2003	Yasuyuki Sakai	118061	8818
25944	7590	05/16/2006		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER FLANIGAN, ALLEN J	
			ART UNIT 3753	PAPER NUMBER
DATE MAILED: 05/16/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/733,472	SAKAI, YASUYUKI	
	Examiner	Art Unit	
	Allen J. Flanigan	3753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8 and 9 is/are rejected.
- 7) ☒ Claim(s) 5-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's election with traverse of Embodiment I, the tube coupling subspecies of Figs. 7-9, and the tube subspecies of Fig. 4 in the reply filed on 4/5/2006 is acknowledged. The traversal is on the ground(s) that a search of the dozens of possible combinations/permutations of these separate features allegedly could be searched and examined "without serious burden". This is not found persuasive, nor is it a proper traversal. A proper traversal should point out the alleged errors in the restriction requirement, i.e. why the holding of patentable distinctness among these species and subspecies is incorrect (an admission on the record of patentable indistinctness would suffice). Applicant's assertion of undue burden is also not persuasive. Had applicant elected embodiment II or III, it would be conceded, but for Embodiment 1, there are nine different permutations of the different expansion joint and tube configurations possible. All involve distinct features that would have to be searched for and examined.

The requirement is still deemed proper and is therefore made FINAL.

Claim 4 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/5/2006.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Inoue et al.

Please see the Figs. 23-25 embodiment, which shows every element claimed (note compressing leaf spring 9a and holes 48 formed in the tube ends).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Inoue et al.

The features recited in the above claims are clearly found in Inoue et al.; the rejection is based alternatively on sections 102/103 of the code since it is not clear that there is sufficient teaching or suggestion to use the compressing means shown in the Figs. 9-10 embodiment with the semiconductor cooling

device shown in the Figs. 23-25 embodiment. Anticipation has been described as being present when each and every element of the claims is found within the "four corners" of a reference, and this is certainly true of Inoue et al. Assuming *arguendo* that features from one embodiment, clearly shown to be equivalents by virtue of performing the same function (the leaf spring 9a and the tension rods and compression plates of Figs. 9-10), must nonetheless be shown expressly to be combinable with the remaining claimed features or substitutable in different embodiments for anticipation to exist, it would clearly have been obvious to one of ordinary skill in the art to employ the compression means of Figs. 9-10 in place of the U-shaped leaf spring member, such being a mere substitution of known equivalents.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al. in view of Ohara et al.

Inoue et al. shows flat cooling tubes of the extruded type in most or all embodiments. It is known in the art that another method of forming a flat, multiple passage tubular structure is through the use of paired plates sandwiching a corrugated sheet/internal fin (see Ohara et al. Fig. 9). In view of the express recognition in the art of the equivalency of forming multiple internal passage flat tubing in these ways, it would have been an obvious substitution of equivalents to form the tubes of Inoue et al. in this manner.

Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Allemandou is cited as an alternative to Ohara et al. The remaining references show electrical component stacks cooled by parallel tubular structures.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen J. Flanigan whose telephone number is (571) 272-4910. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (571) 272-4930. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3753

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Allen J. Flanigan
Primary Examiner
Art Unit 3753

AJF